

REMARKS

This is a response to the nonfinal Office Action of October 6, 2004. Upon entry of this response, claims 1-6, 8-16 and 18-21 are pending in the application. With this response, claims 7, 17 and 22-26 are canceled without prejudice, and claims 1, 2, 6, 11, 12, 16, 18 and 21 are amended as indicated.

In the Office Action, claims 22 and 23 stand rejected under 35 U.S.C. §102(b), and claims 1-6, 8-16, 18-21 and 24-26 stand rejected under 35 U.S.C. §103(a). Furthermore, the Applicant respectfully acknowledges the Examiner's determination that claims 7 and 16 are allowable if rewritten in independent form. The Applicant respectfully requests that there be reconsideration of the claims in view of the Applicant's remarks.

Allowable Subject Matter

Applicant appreciates the Examiner's indication that claims 7 and 16 would be allowable if amended to include all of the limitations of the base claim and any intervening claims. Accordingly, Applicant has amended the claims in accordance with the Examiner's instructions and respectfully asserts that they are now in condition for allowance.

Rejections Under 35 U.S.C. §103(a)

In the Office Action, claims 1-6, 8-16, 18-21 and 24-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable. As stated above, the Examiner indicated that dependent claim 7 and 16 were allowable in free written in independent form. The Applicant respectfully requests that

the amendment being filed herewith be entered and that there be reconsideration of the claims amended.

With reference to independent claim 1

With regard to the rejected independent claim 1, the Applicant respectfully traverses the Office Action position that *Lin et al. (USPN 6203756)* in the view of *Easton (GB 2244919)* teaches an endoscope disinfecting apparatus as now claimed.

In particular, Applicant respectfully asserts that neither *Lin et al.*, *Mariotti (USPN 5882589)*, *Eakes (USPN 4125062)* or *Easton* teaches an endoscope disinfecting apparatus with a “suction hose having a first end and a second end, said first end being connected to said lid and said second end being connected to said fan housing such that said fan is communicatively coupled to a vapor space”, as now claimed in claim 1.

These aspects of the present invention, as recited in claim 1, clearly are neither taught nor suggested by the prior art of record. Therefore, the prior art of record does not teach or suggest all the elements of the claimed invention as required by U. S. Patent Law. *In re Royka*, 490 F.2d 981,180 USPQ 580 (CCPA 1974). Consequently, the reasons stated in the Office Action to support the rejection of claim 1 are inadequate and, therefore, should be withdrawn.

With reference to independent claim 11

With regard to the rejected independent claim 11, the Applicant respectfully traverses the Office Action position that *Lin et al. (USPN 6203756)* in the view of *Easton (GB 2244919)* teaches an endoscope disinfecting apparatus as now claimed.

In particular, Applicant respectfully asserts that neither *Lin et al.*, *Mariotti* (USPN 5882589), *Eakes* (USPN 4125062) or *Easton* teaches an endoscope disinfecting apparatus with “an endoscope body section connected to said disinfecting basin that disinfects a body and eye piece of the endoscope, wherein said disinfecting basin is a pouch connected to a side of said endoscope body section”, as now claimed in claim 11.

These aspects of the present invention, as recited in claim 11, clearly are neither taught nor suggested by the prior art of record. Therefore, the prior art of record does not teach or suggest all the elements of the claimed invention as required by U. S. Patent Law. *In re Royka*, 490 F.2d 981,180 USPQ 580 (CCPA 1974). Consequently, the reasons stated in the Office Action to support the rejection of claim 11 are inadequate and, therefore, should be withdrawn.

With reference to independent claim 21

With regard to the rejected independent claim 21, the Applicant respectfully traverses the Office Action position that *Lin et al.* (USPN 6203756) in the view of *Easton* (GB 2244919) and *Mariotti* (USPN 5882589) teaches an endoscope disinfecting apparatus as now claimed.

In particular, Applicant respectfully asserts that neither *Lin et al.*, *Mariotti* or *Easton* teaches an endoscope disinfecting apparatus with “wherein said endoscope disinfecting apparatus includes a support cylinder and an insertion tube section coiled outside and around said support cylinder”, as now claimed in claim 21. Applicant respectfully traverse is the assertion that *Mariotti* teaches that the assertion to section is coiled around a support cylinder, as indicated by the office action in figure 3, item 22. Applicant observed that the reference actually teaches that the insertion tube section is coiled in the side of the item indicated as a support cylinder.

These aspects of the present invention, as recited in claim 21, clearly are neither taught nor suggested by the prior art of record. Therefore, the prior art of record does not teach or suggest all the elements of the claimed invention as required by U. S. Patent Law. *In re Royka*, 490 F.2d 981,180 USPQ 580 (CCPA 1974). Consequently, the reasons stated in the Office Action to support the rejection of claim 21 are inadequate and, therefore, should be withdrawn.

With reference to dependent claims 2-10, 12-16 and 17-20

Claims 2-10, 12-16 and 17-20 are dependent upon claims 1 or 11, which are believed to be allowable over the prior art made of record. Therefore, these claims are allowable as a matter of law. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

With reference to all claims

The Applicant also respectfully traverses the Office Action allegation of obviousness for all remaining claims. The allegation of obviousness is traversed, because the motivation to combine the teachings of *Lin et al.* in the view of *Mariotti*, *Easton*, *Eakes* and *Hillebrenner et al.* (*USPN* 5534221) to make the claimed invention obvious is unsupported by any teaching or suggestion in prior art of record. The Applicant respectfully declares that the motivation expressed in the Office Action is nothing more than a general assertion that the motivation to combine the references is well known and generally available to one of ordinary skill in the art.

The Applicant asserts that this is insufficient grounds for combining references as required by the Federal Circuit. Applicant asserts that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to

suggest both the combination of elements and the structure resulting from the combination. See, *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991)

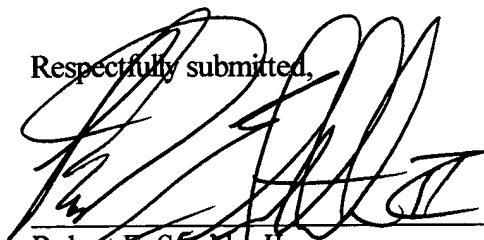
In order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to create an endoscope disinfecting apparatus for disinfecting an endoscope, as claimed by the Applicant. Applicant respectfully traverses the desirability of each modification, because the mere fact that the prior art could be so modified would not have made each modification obvious unless the prior art suggested the desirability of each modification. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780 (Fed Cir. 1992).

Accordingly, the Applicant respectfully asserts that there is no incentive to combine *the prior art*, and that the combination of the references is improper. Therefore, Applicants respectfully request that all rejections of this combination be withdrawn.

CONCLUSION

For all of these reasons, the Applicant respectfully submits that claims 1-6, 8-16 and 18-21 are patentably distinct over the cited and relied upon prior art under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a). In view of all of the foregoing, the Applicant respectfully agrees that claims 1-6, 8-16 and 18-21 are in condition for allowance. If the Examiner has any questions, the Examiner is requested to contact Robert E. Stachler II at (404) 815-3708.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'R. E. Stachler II', written over a horizontal line.

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